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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/779,729	02/18/2004	Fujikazu Sugimoto	118593	1727

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EXAMINER

IWUCHUKWU, EMEKA DERRICK

ART UNIT	PAPER NUMBER
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2645

DATE MAILED: 11/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/779,729	SUGIMOTO ET AL.	
	Examiner	Art Unit	
	Emeka D. Iwuchukwu	2645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 6-8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 9 and 10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 6-8 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6/3/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-5,9&10, drawn to a data backup system comprising a terminal including a storage device storing data, history of updates and a history of backups, classified in class 707, subclass 200.
 - II. Claim 6, drawn to a mail transmission system, classified in class 709, subclass 206.
 - III. Claims 7&8, drawn to an image-information transmission system, classified in class 348, subclass 207.1.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I, II and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as email, sent from a computer to a portable terminal and invention III also has separate utility such as image transmission between a computer and a camera. See MPEP § 806.05(d).
 3. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II or Group III, restriction for examination purposes as indicated is proper.
 4. During a telephone conversation with Steve Alice on November 7, 2005, a provisional election was made with traverse to prosecute the invention of Group I, claims 1-5,9&10.
- Affirmation of this election must be made by applicant in replying to this Office action.

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Claims 6-8 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Information Disclosure Statement

The information disclosure statement item "2" filed on June 3, 2005 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. **Claim 10** is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The language of the claim raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis

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of statutory subject matter under 35 U.S.C. 101.

Claim 10 claims the non-statutory subject matter of a program. Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer. See, e.g., Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1754 (claim to a data structure per se held non-statutory). Therefore, since the claimed programs are not tangibly embodied in a physical medium, encoded on a computer-readable medium and clearly recited as a computer program then the Applicant has not complied with 35 U.S.C 101.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1,3&9 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent Publication 2001/0014893 A1 to Boothby.

With respect to claims 1&9, Boothby teaches a data backup system and a data backup method to back up data in a data backup system including a wearable computer including a receiving device to receive backup data and a backup-data writing device to write the backup data to a second storage device (paragraphs 2,8,16&20); and a portable information terminal that carries out data communication with the wearable computer (paragraphs 16,59,60); the portable

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information terminal including, a first storage device to store predetermined data, a history of updates of the data, and a history of backups of the data (paragraphs 2,18,16,19,59,60) and an extracting device to read the update history and the backup history from the first storage device, compare the time of the last backup indicated by the backup history with the time of the last update indicated by the update history, search for data newly updated since the time of the last backup, extract the newly updated data as the backup data, and a data sending device to send the backup data extracted (paragraphs 2,18,16,19,59,60).

With respect to claim 3, Boothby teaches the data backup system according to Claim 1, the predetermined data and the backup data each including an identifier representing the predetermined data, and the backup-data writing device compares an identifier of backup data stored in advance in the second storage device with an identifier of the backup data received, and writes the backup data received in the second storage device when these identifiers coincide with each other (paragraphs 2,5,6).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

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2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

13. **Claim 2** is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Publication 2001/0014893 A1 to Boothby in view of U.S. Patent Publication 2003/0120685 to Duncombe et al. (*hereinafter Duncombe*).

Boothby teaches the data backup system according to claim 1. Boothby fails to expressly disclose the portable information terminal further comprising: a data compressing device to compress the backup data, and the sending device sends the compressed backup data, and the wearable computer further comprises: a data expanding device to expand the compressed backup data received by the receiving device.

In the same field of endeavor, Duncombe teaches a similar system where the portable information terminal further comprises: a data compressing device to compress the backup data, and the sending device sends the compressed backup data, and the wearable computer further comprises: a data expanding device to expand the compressed backup data received by the receiving device (paragraph 29).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system disclosed by Boothby to include a data compressing device in the portable information terminal and a decompressing device in the wearable computer to reduce the time taken for the data transfer.

14. Claims 4&5 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Publication 2001/0014893 A1 to Boothby in view of U.S. Patent Publication 2002/0010807 A1 to Multer et al. (*hereinafter Multer*).

With respect to claim 4, Boothby teaches the data backup system according to Claim 1. Boothby fails to specifically mention the first storage device further storing in advance a predetermined communication identifier, the sending device sending a communication-connection request using the communication identifier, and the wearable computer further comprising: an authenticating device to compare a communication identifier received by the receiving device with a Communication identifier stored in advance in the second storage device, and permitting connection by the portable information terminal when these identifiers coincide with each other.

In the same field of endeavor, Multer teaches a similar system wherein the first storage device further storing in advance a predetermined communication identifier, the sending device sending a communication-connection request using the communication identifier, and the wearable computer further comprising: an authenticating device to compare a communication identifier received by the receiving device with a Communication identifier stored in advance in the second storage device, and permitting connection by the portable information terminal when these identifiers coincide with each other (paragraphs 222-224).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the communication identifier and the authenticating device for security.

With respect to claim 5, Boothby in view of Multer teaches a wearable computer that carries out data communication with a portable information terminal (Boothby, paragraphs 16,59&60) comprising: a receiving device to receive a communication identifier of the portable information terminal from the portable information terminal; an authenticating device to compare the communication identifier received with a communication identifier stored in

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advance in predetermined storage device, and permitting connection by the portable information terminal when these identifiers coincide with each other; a second receiving device to receive backup data from the portable information terminal when connection has been permitted by the authenticating device; and a backup-data writing device to write the backup data in the storage device (Multer, paragraphs 222-224).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Emeka D. Iwuchukwu whose telephone number is (571) 272-5512. The examiner can normally be reached on M-F (9AM - 5.30PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

EDI

**OVIDIO ESCALANTE
PATENT EXAMINER**

Ovidio Escalante